REMARKS

Claims 25-37 and 39-53 are pending. Claims 31 and 53 have been amended. Claim 26 is withdrawn from consideration. In light of the amendments and remarks set forth below, Applicants respectfully submit that each of the pending claims is in immediate condition for allowance.

In item 2 on page 2 of the above-identified Office action, claims 31-32 and 53 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

More specifically, the Examiner stated that there is no antecedent basis for the feature "the at least one third power switch transistor" in claim 31 and for the feature "the at least one two power switch transistor" in claim 53.

The Examiner's comments have been considered and claims 31 and 53 have been amended to recite "the at least one ***second*** power switch transistor" (emphasis omitted in the claims).

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above-noted changes to the claims are provided solely for the purpose of satisfying formal requirements. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

Claims 25, 27-37, 45-50, and 52-53 have been rejected as being anticipated by *Matsuzaki et al.* (US 6,500,715) under 35 U.S.C. § 102.

In items 3 and 4 on pages 5 and 7, respectively, of the Office action, claims 39-42 and claims 43-44, respectively, have been rejected as being obvious over *Matsuzaki et al.* (US 6,500,715) in view of *Sani et al.* (US 6,794,914) under 35 U.S.C. § 103.

The rejections and the Examiner's comments have been considered. However, as will be explained below, it is believed that the claims are patentable over the applied reference(s).

In the *Response to Arguments* in item 5 on pages 8 and 9 of the Office action, the Examiner has stated that:

> Applicant argues that Matsuzaki et al. fails to disclose "the magnitude of the first and/or second value is greater than the magnitude of the third value" is not persuasive. ***Figure 14*** clearly discloses the power switch (MN 1) and the transistors within the latch LH 1 are thick film MOS transistors. The switching transistors (TP1 to TP3) are thin film MOS transistors. Column 20, lines 60-64 further teaches that thick film MOS transistors have threshold voltage of 0.5 volt and thin film transistors have threshold voltage of 0.1 volts. Therefore, the limitations of "the magnitude of the first and/or second value is greater than the magnitude of the third value" are fully met.

(Emphasis added.)

The passage of *Matsuzaki et al.* cited and applied by the Examiner states:

> Several embodiments as will be shown in ***FIG. 22 and its following figures*** of the drawing are drawn to the circuit configuration basically employing therein a combination of thick-film MOS transistors of high threshold value--such as 0.5 volts, which may render subthreshold current leakage negligible--and thin-film MOS transistors of low threshold value such as 0.1 volt, or more or less, by way of example.

(Emphasis added.)

The Examiner is combining ***two*** different embodiments of *Matsuzaki et al.*: The embodiment shown in FIG. 14 and the embodiments illustrated in FIG. 22 and following drawings.

According to MPEP § 2131, to anticipate a claim, the reference must teach every element of the claim.

> ... "The ***identical invention*** must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

(Emphasis added.)

According to MPEP § 2131 and case law, anticipation requires the same or identical invention. Combining the features or teaching of two different embodiments, even if disclosed in the same reference, is not proper for an anticipation rejection. The Examiner may consider whether or not an obviousness rejection may or may not be more appropriate than maintaining the anticipation rejection.

As stated in the last response, *Matsuzaki et al.* explicitly states in regard to the embodiment shown in FIG. 14 that "***no particular*** limitations are given with regard to the transistor threshold value". *Matsuzaki et al.* merely states that it is "***recommendable*** that the thin-film MOS transistors are of low threshold value whereas the thick-film ones are higher in threshold value than the former." Recommendable is ***not*** necessarily, as required for an inherent disclosure. *Matsuzaki et al.* therefore does not disclose the ***identical device*** as recited in the claims where the threshold voltage of the storage transistors (first value) and/or the threshold voltage of the first power switch transistor (second value) is greater that the threshold voltage of the switching transistors (third value).

It is accordingly believed to be clear that *Matsuzaki et al.* does not show the features of claims 29 and 51-53. Claims 29 and 51-53 are, therefore, believed to be patentable over *Matsuzaki et al.* and because claims 25-28, 30-31, 33-37, and 39-50

are ultimately dependent on claim 29, and claim 32 is dependent on claim 53, they are believed to be patentable as well.

Considering the deficiencies of the primary reference, *Matsuzaki et al.*, it is believed not to be necessary at this stage to address the secondary reference, *Sani et al.*, applied in the rejection of dependent claims 39-44, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying or combining the references as required by MPEP § 2143.

In view of the foregoing, reconsideration and allowance of claims 25-37 and 39-53 are solicited.

According to MPEP § 706.07(a) [Final Rejection, When Proper on Second Action]:

> Under present practice, second or any subsequent actions on the merits shall be final, ***except*** where the examiner introduces a ***new ground of rejection*** that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed ...

(Emphasis added.)

By combining two different embodiments, even when applying the same reference, the Examiner introduced a new ground of rejection. Since the new rejection was not necessitated by applicant's amendment of the claims (the independent claims were not amended) nor based on information submitted in an information disclosure statement (the same reference was applied), the Examiner requested to reconsider the finality of the outstanding Office action.

In view of the foregoing, the Examiner is requested to reconsider the finality of the outstanding Office Action.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: December 13, 2006

Respectfully submitted,

By_____

Ian R. Blum
Registration No.: 42,336
DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas
New York, New York 10036-2714
(212) 277-6500
Attorney for Applicants

IRB/mgs